

**REMARKS**

Claims 1-53 are pending in this application. By this Amendment, Applicants have amended claims 1, 50 and 53 and added claims 54-68. Reconsideration of the above-identified application in view of the foregoing amendments and the following remarks is respectfully requested.

**Rejections Under 35 U.S.C. § 103:**

Claims 1-3, 7-15, 17, 50 and 53 were rejected under 35 U.S.C. §103 as being unpatentable over Asai. Claims 4 and 16 were rejected under 35 U.S.C. §103 as being unpatentable over Asai in view of Gerszberg. Claims 18 and 19 were rejected under §103 as being unpatentable over Gerszberg and Asai in view of Nanba. Claim 5 was rejected under §103 as being unpatentable over Asai in view of Hyakudai. Claim 6 was rejected under §103 as being unpatentable over Asai in view of Munyan. Claims 20-23, 27-35, 37, 41, 47-49, 51 and 52 were rejected under §103 as being unpatentable over Asai in view of Strietzel. Claims 24, 36 and 42 were rejected under §103 as being unpatentable over Asai and Strietzel in view of Gerszberg. Claim 44 was rejected under §103 as being unpatentable over Asai and Strietzel in view of Masahiro. Claims 38 and 39 were rejected under §103 as being unpatentable over Asai and Strietzel in view of Nanba. Claims 25 and 43 were rejected under §103 as being unpatentable over Asai and Strietzel in view of Hyakudai. Claims 40 and 45 were rejected under §103 as being unpatentable over Asai and Strietzel in view of Hamzy. Claim 26 was rejected under §103 as being unpatentable over Asai and Strietzel in view of Munyan.

Claims 1, 20, 41 and 50-53 are independent.

**Claims 1, 20, 50, 51 and 53**

Claims 1, 50 and 53 were rejected under 35 U.S.C. §103 as being unpatentable over Asai. Claims 20 and 51 were rejected under §103 as being unpatentable over Asai in view of Strietzel.

Asai and Strietzel were filed on January 25, 2001 and February 26, 2001, respectively. The enclosed Rule 131 declaration clearly demonstrates that Applicants conceived of the subject matter of claims 1, 20, 50, 51 and 53 prior to January 25, 2001, and following conception, diligently reduced their idea to practice. Thus, Applicants respectfully submit that neither Asai nor Strietzel, which were filed on or after January 25, 2001, is prior art to the foregoing claims.

Accordingly, Applicants respectfully request that the present rejection of these claims in view of Asai alone or in combination with Strietzel be withdrawn.

**Claims 41 and 52**

Claim 41 includes the feature of “receiving notice that the terminal has transferred the requested content to a second terminal having a bistable display; and in response to the notice, transmitting the advertisement linked to the requested content to the second terminal.” In rejecting claim 41, the Office Action provides “Strietzel disclose storing advertisements linked to the stored content (see section [0012] for example).” This, however, clearly does not teach or suggest the foregoing feature of Applicants’ invention.

In the prior Office Action (mailed April 26, 2004), it was asserted that this feature is found in Asai on “page 6, sections [0114], [0120], and page 11, section [0186]”. In traversing the rejection, Applicant noted that the cited passages of Asai instead merely disclose a host apparatus transmitting information such as an advertisement from a transmission tower to

portable telephones owned by users. This too, however, does not teach or suggest the feature of “receiving notice that the terminal has transferred the requested content to a second terminal having a bistable display; and in response to the notice, transmitting the advertisement linked to the requested content to the second terminal.”

Moreover, with respect to the Office Action’s contention that Strietzel discloses storing advertisements linked to the stored content, Applicants respectfully disagree. Strietzel is directed to providing different ways for an individual to pay for content, one of which is by agreeing to receive advertisements. In Strietzel, however, although content and advertisements are transmitted to the individual in the same “package”, the stored advertisements are not linked to the stored content, as disclosed by Applicants (see, e.g., FIG. 3B and accompanying text) and as required by claim 41. Rather, in Strietzel, an advertisement is selected from storage for transmission to an individual based on, e.g., information in his or her personal profile concerning product, service and/or brand preferences.

Accordingly, Applicants respectfully submit that claim 41 is allowable over the combination of Asai and Strietzel. Claim 52 contains limitations similar to those found in claim 41, and thus, is allowable for at least the same reasons.

**Dependent Claims:**

Dependent claim 49, which depends from claim 41, requires receiving information about other terminals that are in close proximity of the terminal; and transmitting advertisements to the other terminals. The Examiner contends that this feature is found in Asai on “page 6, sections [0114], [0120], and page 11, section, section [0186]”. Applicants respectfully disagree. Instead, as noted above, the cited passages of Asai merely disclose a host apparatus transmitting information such as an advertisement from a transmission tower to

portable telephones owned by users. There is no teaching or suggestion in the cited passages of determining whether the portable telephones of Asai are in “close” proximity of one another; at most, there is simply a transmission to portable telephones within operating range of the transmission tower.

Applicants do not believe it necessary at this time to further address the rejections of the dependent claims as Applicants believe that the foregoing arguments and amendments place the independent claims in condition for allowance. Applicants, however, reserve the right to address those rejections in the future should such a response be deemed necessary and appropriate.

**New Claims:**

Applicants have added new claims 54-68 directed to a combination of various features believed to be patentable, including the feature of “storing advertisements linked to the stored content”, discussed above in urging the allowance of claim 41, in combination with the other features recited in the claims. An examination on the merits of these new claims is respectfully requested.

\* \* \*

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance, and an early and favorable examination on the merits is respectfully requested.

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees which may be required by this response, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4208-4014. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4208-4014. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

By: \_\_\_\_\_

  
Peter N. Fill  
Registration No. 38,876

Dated: March 31, 2005

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.  
3 World Financial Center  
New York, NY 10281-2101  
(212) 415-8700 Telephone  
(212) 415-8701 Facsimile